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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,705	07/17/2003	Skott C. Klebe	C0011/7005	1536

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LAW OFFICES OF PAUL E. KUDIRKA  
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SUITE 300  
BOSTON, MA 02109

EXAMINER
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SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary****Application No.**

10/621,705

**Applicant(s)**

KLEBE ET AL.

**Examiner**

Matthew B. Smithers

**Art Unit**

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10,11,13-17 and 20-30 is/are rejected.
- 7) ☒ Claim(s) 2,8,9,12,18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/09/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed October 9, 2003 has been placed in the application file and the information referred to therein has been considered as to the merits.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-30 are computer program product claims comprising a computer useable medium having computer program code for executing the method of claims 1-10. Applicant's specification, paragraph [0109], clearly discloses that the program code (computer instructions) within the computer useable medium of the computer program product can be either stored in a memory device (semiconductor, magnetic, etc.) or transmitted through any communications medium (infrared, microwave, etc). The transmission (infrared, microwave, etc) of the program code (computer instructions) lacks the necessary physical article or objects that constitute a machine or manufacture within the meaning of 101. Further, the transmission (infrared, microwave, etc.) is not a combination of chemical compounds forming a composition of matter nor is it a series of steps in a process. Therefore, the

transmission (infrared, microwave, etc.) does not fall within one of the four statutory classes of an invention and as such claims 21-30 are deemed non-statutory.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-7, 10, 11, 13-17, 20, 21, 23-27 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,449,721 granted to Pensak et al.

Regarding claim 1, Pensak meets the claimed limitations as follows:

“A method for rights management of digital content and secure delivery of digital content documents from a publisher site to an unsecure site, the method comprising:

- (a) encrypting each digital content document at the publisher site with a key to generate encrypted document content;
- (b) computing for each document, from the encrypted document content for that document, a document identifier that cannot be derived solely from the encrypted version of the requested document;
- (c) creating a list of document identifier and decryption key pairs;

- (d) assembling the encrypted document content for each content document and the list into a distribution archive;
- (e) encrypting the distribution archive with a scheduled key;
- (f) installing a content server at the unsecure site; and
- (g) sending the distribution archive from the publisher site to the content server.” see column 2, lines 18-65; column 3, lines 19-30 and column 7, line 6 to column 8, lines 67.

Regarding claim 3, Pensak meets the claimed limitations as follows:

“The method of claim 1 wherein step (b) comprises computing a document identifier from the encrypted document content and a text string at the publisher site.” see column 3, lines 19-30.

Regarding claim 4, Pensak meets the claimed limitations as follows:

“The method of claim 1 further comprising:

- (h) at the unsecure site, decrypting the distribution archive with the scheduled key, extracting the encrypted document content and storing the encrypted document content in a storage located at the unsecure site.” see column 2, lines 37-65 and column 7, line 6 to column 8, lines 67.

Regarding claim 5, Pensak meets the claimed limitations as follows:

“The method of claim 4 wherein a user at the unsecure location accesses the content server from a browser and wherein the method further comprises:

- (i) downloading a secure viewer program into the browser;
- (j) using the viewer program to request a document from the content server;

- (k) downloading an encrypted version of the requested document from the content server to the viewer; and
- (l) using the viewer to calculate a document identifier from the encrypted version of the requested document and to send the document identifier to the content server.” see column 2, lines 37-65 and column 7, line 6 to column 8, lines 67.

Regarding claim 6, Pensak meets the claimed limitations as follows:

“The method of claim 5 further comprising:

- (m) using the document identifier in the content server to retrieve a decryption key from the list and downloading the decryption key to the viewer program; and
- (n) using the downloaded key in the viewer program to decrypt the encrypted version of the document and present the document to the user.” see column 2, lines 37-65 and column 7, line 6 to column 8, lines 67.

Regarding claim 7, Pensak meets the claimed limitations as follows:

“The method of claim 1 further comprising:

- (h) monitoring content access at the unsecure site; and
- (i) creating a log file at the unsecure site from the monitored activities.” see column 3, lines 31-42.

Regarding claim 10, Pensak meets the claimed limitations as follows:

“The method of claim 7 wherein step (h) comprises monitoring user activities including login to the system, registration, creation of a user profile and the

reading and printing of selected content documents.” see column 3, lines 31-42 and column 4, lines 45-56.

Claims 11, 13-17 and 20 are apparatus claims that are substantially equivalent to method claims 1, 3-7, and 10. Therefore, claims 11, 13-17 and 20 are rejected by a similar rationale.

Claims 21, 23-27 and 30 are claims to a computer program product that are substantially equivalent to method claims 1, 3-7, and 10. Therefore, claims 21, 23-27 and 30 are rejected by a similar rationale.

#### ***Allowable Subject Matter***

Claims 2, 8, 9, 12, 18, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 2 and 12, the cited prior art fails to specifically teach wherein step comprises compressing each document before encrypting the document.

With respect to claims 8, 9, 18 and 19, the cited prior art fails to specifically teach sending the log file to the publisher site in return for a distribution archive containing new content; extracting the contents of the log file at the publisher site; formatting the

extracted contents and providing a report from the formatted contents to a reporting client.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Williams (US 20020002541) discloses a system for distributing digital content to a user.

B. Raley (US 7,073,199) discloses a system for secure distribution of electronic documents to a client computer.

C. Hamada et al (US 7,035,826) discloses a system for distributing digital content using a copyright rental scheme.

D. Schmeidler et al (US 7,017,188) discloses a system for secure delivery of content over broadband networks.

E. Carpentier et al (US 6,807,632) discloses a system for creating hash asset identifiers for stored content.

F. Yano et al (US 6,711,594) discloses a system for secure distribution of archive data.

G. Arnold et al (US 6,289,452) discloses a system for delivering digital products to a user.


H. Masinter (US 5,742,807) discloses a system for indexing documents using a hash service.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Matthew B Smithers  
Primary Examiner  
Art Unit 2137